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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,361	04/09/2001	Hitoshi Kawamukai	YAMAP0572USA	1248

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EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,361

Applicant(s)

KAWAMUKAI ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Appeal Brief submitted on February 22, 2005. In view of Non-Statutory subject matter, PROSECUTION IS HEREBY REOPENED.

Status of the claims

2. The only pending claim 6 is examined herein as follows.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter. The body of claim 6 recites "menu item coordinate information", "image information", and "valid duration information" and including in a wherein clause reciting the insertion of "menu item coordinate information" and "valid duration information" in the transport stream data. Thus, Claim 6 recites merely arrangements and/or stored ("recorded") data on a "recording medium" so as to be read or outputted by a computing device without creating any functional interrelationship. Such descriptive material alone does not impart functionality. Thus, since claim 6 does not define a functional interrelationship among

the data (the limitations), and since no computing process is performed utilizing the data, and as such is Non-Statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Saeki et al Pat No 6,067,400.

Saeki et al (US Pat No 6,067,400) relates to an optical disc that stores multimedia data, a reproduction apparatus, and a reproduction method for reproducing such an optical disc.

As illustrated in Figs. 5-11, etc, Saeki discloses a recording medium (e.g., DVD) a machine-readable recording medium comprising a data area for storing at least one

object that has sub-picture data and moving picture data, wherein such data stored is either system stream data or transport stream data (column 29, lines 28-48).

The transport stream data includes menu item coordinate information (see menu image 1 or menu image 2, Figs. 36 and 37, see also start and end X-Y coordinates for the menu button, Figs. 12 and 14; column 13, lines 18-58) representing a display location of a menu item.

The transport stream data also includes image information (see display images 1 through 3, Fig. 35) for representing images.

The transport stream data also includes valid duration information (valid highlight start time and highlight end time) for representing the duration for which the menu item coordinate information is valid (column 24, lines 60-column 25, lines 8; Figs. 12 and 13).

Saeki further discloses that the menu item coordinate information (e.g., Fig. 14; column 15, lines 16-34) and valid duration information (e.g., Fig. 13) are inserted or stored (see the stored highlighted data, Fig. 37) in the transport stream data at predetermined time periods. As illustrated in Fig. 14, the highlighted data includes start and end X-Y coordinates information and menu item (button) information (column 13, lines 27-58).

Response to Arguments

5. Applicant's arguments filed 10/25/2004 have been fully considered but they are not persuasive. Applicant repeatedly argues that Saeki et al does not describe "transport stream data" as specified in claim 6. The examiner disagrees. As described in column 29, lines 28-48 and as illustrated in several figures, for example, in Figs. 5-

Art Unit: 2173

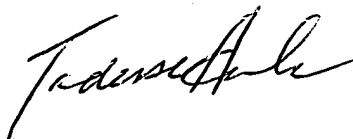
11, etc, Saeki et al illustrates a recording medium on which stream data including transport stream data has been recorded. On the other hand, the invention merely suggests, "so called transport stream" otherwise the disclosure is largely describing MPEG2 stream (program stream). Furthermore, while the invention describes data is inserted in the MPEG2 stream data, " but claim 6 describes "...information is inserted in the transport stream data ..." Taking applicant's merely indication of "transport stream data" into account, the presented argument is not persuasive. Thus, Saeki et al anticipate claim 6.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 273-4048 Art Unit 2173.

7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu
Patent Examiner in Art Unit 2173



April 29, 2005